

REMARKS

By this amendment, Applicants have amended claims 12, 20, 23-26, and 31 and canceled claims 17-19 and 28-30, without prejudice. As a result, claims 12-16, 20-27, and 31-33 are pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to pursue the full scope of the subject matter of the original claims, or claims that are potentially broader in scope, in the current and/or a related patent application. Reconsideration in view of the following remarks is respectfully requested.

Initially, Applicants thank the Examiner for his time and courtesy in conducting a telephone interview with Applicants' undersigned representative on 30 June 2009. During the interview, various aspects of the objections of claims 12, 20, and 31, and rejections of claims 12-16, 20-27, and 31-33 under U.S.C. § 112 were discussed. No exhibits were demonstrated during the interview, and agreement was reached as to some of the objections and rejections as a result of the interview. The substance of the interview is included in the following remarks.

In the Final Office Action, the Office objects to claims 12, 20, and 31 for including a wherein phrase that allegedly makes the described features optional. By this response and as agreed during the telephone interview, Applicants have amended the claims to remove the wherein clause objected to by the Examiner. As a result, Applicants respectfully request withdrawal of the objection to claims 12, 20, and 31 as allegedly including an optional feature.

Further, the Office rejects claims 12-16, 20-27, and 31-33 under 35 U.S.C. § 112, first paragraph as allegedly not being enabled by the specification. In particular, the Office alleges that the specification does not discuss generating and transmitting print files and prompting the user without any further user interaction after a request to print.

With respect to claims 12, 20, and 31, as discussed during the telephone interview, Applicants note that several portions of the specification and figures describe generating a print file, transmitting the print file to a server, and launching a web browser for document viewing without further user interaction. See, e.g., specification, p. 17 and Fig. 7, 605, 610, 620; and pp. 18-20 and Fig. 9, 506, 532, 574. Additionally, as discussed during the telephone interview, the specification and figures describe generating a print file, transmitting the print file to a server, and prompting the user, in which the user is presented with a sign in screen for authentication prior to being prompted. See, e.g., specification, p. 23 and Fig. 15G.

Even if, *arguendo*, entry of user credentials or verification of stored user credentials via a sign in screen comprises user interaction, Applicants submit that one skilled in the art is readily enabled by the specification to make and use system software for use on a client, which generates a print file, transmits the print file to a server, and prompts a user to configure and preview a bound copy without the user being presented with a sign in screen for authentication. For example, one skilled in the art would recognize that the various processes described in the specification that do not include presentation of a sign in screen prior to launching a web browser can be modified to include prompting the user prior to launching the web browser as described elsewhere in the specification. Similarly, one skilled in the art would recognize that a process that

describes presenting a sign in screen and prompting a user can be implemented without presenting the sign in screen. To this extent, one skilled in the art would understand that prompting a user for a desired next action is entirely unrelated to authenticating the user and therefore, the specification enables one skilled in the art to implement one (e.g., prompting the user) without implementing the other (presenting a sign in screen).

In light of the above, Applicants respectfully request withdrawal of the objection to claims 12-16, 20-23, and 31-33 as allegedly not being enabled by the specification.

With respect to claim 24, Applicants note that claim 24 does not require that the user be prompted. Further, as discussed above, Applicants note that several portions of the specification and figures describe generating a print file and transmitting the print file to a server without further user interaction. See, e.g., specification, p. 17 and Fig. 7, 605, 610; and pp. 18-20 and Fig. 9, 506, 532. As a result, Applicants respectfully request withdrawal of the objection to claims 24-27 as allegedly not being enabled by the specification.

Additionally, the Office alleges that claims 12-16, 20-27, and 31-33 contradict themselves by stating that prompting the user to preview a bound copy of the print file is performed without further user interaction, while the claim requires that a configuration interface be requested by the user.

With respect to claims 12, 20, and 31, Applicants note that prompting a user to preview a bound copy does not imply that the bound copy must exist prior to the prompting. Regardless, Applicants have amended claims 12, 20, and 31 to state that the user is prompted to configure and preview a bound copy of the document using a browser. Applicants submit that this amendment does not require further search and

consideration by the Office since the prompting has already been searched by the Office. With respect to claim 24, Applicants note that the claim does not require that the user be prompted. As a result, Applicants respectfully submit that claims 12-16, 20-27, and 31-33 do not contradict themselves.

Further, the Office rejects claims 20-27 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In particular, the Office alleges that the claims include "means for" language that is modified by some structure, material, or acts recited in the claims. By this response and as agreed during the telephone interview, Applicants have amended the claims to remove the "means for" language. As a result, Applicants respectfully request withdrawal of the rejections of claims 20-27 as allegedly being indefinite.

Further, the Office rejects claim 28 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,134,568 (Tonkin). By this response, Applicants have canceled claim 28, without prejudice, in order to facilitate early allowance of the presently claimed subject matter. As a result, the rejection of claim 28 as allegedly being anticipated by Tonkin is moot in view of the amendments herein.

Further, the Office rejects claims 17, 19, and 31 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske). By this response, Applicants have canceled claims 17 and 19, without prejudice, in order to facilitate early allowance of the presently claimed subject matter. As a result, the rejections of claims 17 and 19 as allegedly being unpatentable over Adamske are moot in view of the amendments herein.

With respect to claim 31, in view of Applicants amendments and remarks above with respect to the objection and rejection of claim 31 as allegedly being indefinite, Applicants respectfully submit that claim 31 is allowable as indicated in the Final Office Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request withdrawal of the rejection of claim 31 as allegedly being unpatentable over Adamske.

Further, the Office rejects claims 12-16, 18, 20-27, 29, 30, 32, and 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 12, in view of Applicants amendments and remarks above with respect to the objection and rejection of claim 12 as allegedly being indefinite, Applicants respectfully submit that claim 12 is allowable as indicated in the Final Office Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request withdrawal of the rejections of claim 12 and claims 13-16 and 32-33 as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claims 18, 29, and 30, by this response, Applicants have canceled claims 18, 29, and 30, without prejudice, in order to facilitate early allowance of the presently claimed subject matter. As a result, the rejections of claims 18, 29, and 30 as allegedly being unpatentable over Adamske in view of Tonkin are moot in view of the amendments herein.

With respect to claim 20, in view of Applicants amendments and remarks above with respect to the objection and rejection of claim 20 as allegedly being indefinite, Applicants respectfully submit that claim 20 is allowable as indicated in the Final Office Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request

withdrawal of the rejections of claims 20 and claims 21-23, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 24, in view of Applicants amendments and remarks above with respect to the rejection of claim 24 as allegedly being indefinite, Applicants respectfully submit that claim 24 is allowable as indicated in the Final Office Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request withdrawal of the rejections of claims 24 and claims 25-27, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary and/or in a related patent application, either of which may seek to obtain protection for claims of a potentially broader scope.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

/John LaBatt/

John W. LaBatt, Reg. No. 48,301
Hoffman Warnick LLC
75 State Street, 14th Floor
Albany, NY 12207
(518) 449-0044 - Telephone
(518) 449-0047 - Facsimile

Dated: 23 July 2009